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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/693,469	10/24/2003	Ted J. Reffett	STD 1141 PA41213.507	2532
23368 7590 07/09/2008 DINSMORE & SHOHL LLP ONE DAYTON CENTRE, ONE SOUTH MAIN STREET SUITE 1300 DAYTON, OH 45402-2023				
EXAMINER				
BATTULA, PRADEEP CHOUDARY				
ART UNIT		PAPER NUMBER		
3725				
MAIL DATE		DELIVERY MODE		
07/09/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/693,469

Applicant(s)

REFFETT, TED J.

Examiner

PRADEEP C. BATTULA

Art Unit

3725

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-28, 30 and 33-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2-28, 33-36, 42 and 43 is/are allowed.
- 6) ☒ Claim(s) 37-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This action is in response to the reply filed on April 21, 2008

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 37 – 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buske.

In regards to Claim 37, Buske discloses a combination packing list and shipping label form (examiner considers one form to constitute multiple labels [at least two] in assembly) configured to be affixed to an object (Figure 7), said form comprising: a packing list comprising: a packing list first ply 20 comprising a front and a back opposite said front (Figure 9, Item 20); a first line of weakness 21 formed in said front of said packing list first ply such that a first printable region is bounded by said packing list first line of weakness (Column 2, Lines 51 – 54; Figure 1, Item 21), said first printable region configured to accept printed indicia thereon (Column 2, Lines 38 – 50; Figure 1); a patterned release layer facing said back of said packing list first ply (Column 2, Lines 33 – 37); an adhesive layer 23 facing each of said back of said packing list first ply and said patterned release layer (Column 2, Lines 33 – 40; Figure 9, Item 23); a packing list second ply 22 comprising a front and a back opposite said front (Figure 9, Item 22), said packing list second ply facing said adhesive layer (Figure 9, Items 22, 23) such that at

least a portion of said front of said second ply is bonded to at least a portion of said back of said first ply to define a multi-ply label (Column 2, Lines 38 – 40); a packing list second line of weakness (created at 29) formed in said back of said packing list second ply such that a second printable region 25 is bounded by said packing list second line of weakness (Column 2, Lines 41 – 44; Figure 9, Items 25, 29); and a shipping label contiguous with said packing list, said shipping label comprising: a shipping label first ply 20 comprising a front and a back opposite said front (Figure 9, Item 20), said front configured to receive indicia printed thereon (Column 2, Lines 51 – 54); a shipping label line of weakness (Column 2, Lines 51 – 54; oval contour) formed in said front of said shipping label first ply (Column 2, Lines 51 – 54; Figure 1, Item 21); an adhesive layer 23 on said back of said shipping label first ply (Column 2, Lines 33 – 40; Figure 9, Item 23); a release layer facing at least a portion of said adhesive layer (Column 2, Lines 35 – 37; Figure 9, Item 22, 23); and a shipping label second ply 22 comprising a front and a back opposite said front (Figure 9, item 22) such that said front of said shipping label second ply includes said release layer (Column 2, Lines 33 – 37; Figure 9, item 22).

With respect to the line of weakness formed in said front of said shipping label first ply to aid in removing said shipping label from said form; it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations.

Furthermore, with respect to the second printable region comprises printing of only preprinted indicia and the first printable region configured to include variable

printed indicia; It has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of package and shipping indicia does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability.

The examiner asserts that the label comprising indicia on different plies is the same structure claimed by applicant and the sole difference is in the content of the printed material. Thus, there is no novel and unobvious functional relationship between the printed matter (varying and non varying indicia) and the substrate (ply's) which is required for patentability.

Accordingly, there being no functional relationship of the printed material to the substrate, as noted above, there is no reason to give patentable weight to the content of the printed matter which, by itself, is non-statutory subject matter.

In regards to Claim 38, Buske further discloses wherein said packing list second line of weakness 24 (Column 2, Lines 48 – 49) is disposed substantially coextensive with said packing list first line of weakness (Figure 9, Items 21, 24).

In regards to Claim 39, Buske further discloses a separable region (Column 2, Lines 51 - 54) disposed about said packing list second line of weakness (at contour 24; the contour goes around the second line of weakness); and a border region disposed

about said shipping label line of weakness (the border region showing the oval cut pattern of the shipping label).

In regards to Claim 40, Buske further discloses wherein said separable region comprises said packing list second printable region and an affixing region adjacent said packing list second printable region (Column 2, Lines 56 – 58; Figure 7; Figure 9, Items 20, 22; Figure 10, Items 20, 22; Figure 3).

In regards to Claim 41, Buske further discloses whereby said form is configured such that said fronts of said first plies of said shipping label and said packing list are substantially coplanar with one another (Column 2, Lines 38 – 50; Figure 9, all labels co-planar).

Allowable Subject Matter

Claims 42, 2- 28, 43, 30, and 33-36 are allowed. Claim 42 is independent with Claims 2 – 28 being dependent and Claim 43 being independent with Claims 30, and 33 - 36 being dependent.

In regards to Claim 42, the prior art alone and in combination does not teach of a first label release layer disposed between at least a portion of said inner surface of said first ply and between first label adhesive layer wherein the first label adhesive layer that is coextensive with said affixing region becomes exposed to allow said first label to be adhesively affixed to an object with said first printable region facing against said object and said second label adhesive layer becomes exposed to allow said second label to be adhesively affixed to an object wherein said indicia faces away from said object.

In regards to Claim 43, the prior art alone and in combination does not teach of said first label can be adhesively affixed to the object with said first printable region facing toward the object and said second label can be adhesively affixed to the object with said indicia facing away from said object.

Response to Arguments

Applicant's arguments filed April 21, 2008 have been fully considered but they are not persuasive with respect to Claims 37 - 41.

The structure is given by Buske and even though the prior art is meant to receive pre printed indicia. The information on the substrate is not providing any functionality and this is shown since the label is just showing information. Functionality with a substrate would be seen as measuring indicia on a container as this provides a relation between the indicia and the substrate where one would know at a certain point on the container a certain amount of substance is held because that amount is indicated by the indicia on the container. The current claim provides no relationship between the indicia and the substrate and only that the substrate can hold indicia. Furthermore, the indicia on the substrates is what determines that the substrate is a packing list and a shipping label, without the indicia it would just be two labels which is what Buske teaches when two label portions are used.

Lastly, Buske is teaching of two plies, the coupon portion shown in Figure 2 is made from the second ply (Column 2, Lines 39 – 45) and the figure just shows what the label looks like when removed from the total construction.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PRADEEP C. BATTULA whose telephone number is (571)272-2142. The examiner can normally be reached on Mon. - Thurs. & alternating Fri. 7:00AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris H. Banks can be reached on 571-272-4419. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/P. C. B./
Examiner, Art Unit 3725
June 25, 2008

/Derris H Banks/
Supervisory Patent Examiner, Art Unit 3725